

RECEIVED

DEC 21 2006

#7

DAE

OFFICE OF PETITIONS

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Hopfensitz et al.

Serial No.: 09/646,944

Filed: September 22, 2000

For: METHOD AND APPARATUS FOR  
CUTTING FOILS

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Examiner: S. Heinrich

Group Art Unit: 1725

Docket: 1093-29 PCT/US

Dated: December 14, 2006

RECEIVED  
10 JAN 2007  
Legal Staff  
International Division

I hereby certify this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on December 14, 2006.

Signed: Jodi A. Cooper

**PETITION TO REVIVE AN UNINTENTIONALLY  
ABANDONED APPLICATION UNDER 37 CFR § 1.137(b)**

The above-identified application became abandoned for failure to file a timely reply to a first Office Action mailed on March 28, 2002 by the Patent and Trademark Office. The date of abandonment is June 28, 2002, the day after the three month period set for reply in the Office Action.

Applicant submits this petition under 37 CFR § 1.137(b) to revive this unintentionally abandoned application and enclose herewith:

1. A petition fee of \$1,500.00 as set forth in 37 CFR § 1.17(m); and
2. An Amendment in response to the March 28, 2002 Office Action.

A fee in the amount of \$1,500.00 pursuant to 37 C.F.R. §1.17(m) is to be charged to Deposit Account No. 08-2461. A duplicate copy of this Petition is being submitted herewith.

A Terminal Disclaimer is not enclosed since the application was filed after June 8, 1995.

The events resulting in the unintentional abandonment of the present application are as follows:

1. The Applicants filed the present application as a national filing of a PCT application on September 22, 2000. A copy of the application Transmittal Letter, which listed the correspondence address for the application as Charles R. Hoffmann, Esq., Hoffmann & Baron, 6900 Jericho Turnpike, Syosset, NY 11791, is attached hereto as Exhibit A. A stamped post card acknowledging receipt of the application is attached hereto as Exhibit B.
2. A Notification of Acceptance of Application (a copy is attached hereto as Exhibit C) was mailed on October 17, 2000 to the Applicants' correspondence address.
3. A Notice of Recordation of Assignment (a copy is attached hereto as Exhibit D) was mailed on December 1, 2000 to the Applicants' correspondence address.
4. On March 12, 2003, Applicants filed a Request for Status of Application (a copy is attached hereto, along with the stamped post card acknowledging receipt by the Patent Office, as Exhibit E), which listed the Applicants' correspondence address.
5. On November 27, 2006, Applicants' attorney contacted the Patent Office to determine the status of the application and on November 29, 2006 spoke to Examiner Samuel M. Heinrich. Examiner Heinrich informed Applicants' attorney that an Office Action had been mailed on March 28, 2002. The Examiner sent a copy of the Office Action and a cited Japanese

application to Applicants' attorney on November 30, 2006. A copy of the facsimile cover sheet is attached hereto as Exhibit F.

6. The March 22, 2002 Office Action (a copy is attached hereto as Exhibit G) was not mailed to the Applicants' correspondence address, but was incorrectly mailed to Charles R. Hoffmann, Esq., Hoffmann & Baron, 350 Jericho Turnpike, Jericho, NY 11753. This was the former address of Hoffmann & Baron up until March 1999. The Applicants did not receive the Office Action prior to November 30, 2006 and, therefore, were not able to file a response.

7. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

The Applicants respectfully request revival of the present application and entry of the Amendment in response to the March 22, 2002 Office Action.

Respectfully submitted,



Kevin E. McDermott  
Registration No.: 35,946  
Attorney for Applicants

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791  
(516) 822-3550  
230558\_1

*Exhibit A*

TRANSMITTAL LETTER TO THE UNITED STATES  
DESIGNATED/ELECTED OFFICE (DO/EO/US)  
CONCERNING A FILING UNDER 35 U.S.C. 371

1093-29 PCT/US

U.S. APPLICATION NO. (IF KNOWN, SEE 37 CFR

INTERNATIONAL APPLICATION NO.  
PCT/DE99/00606INTERNATIONAL FILING DATE  
March 1, 1999PRIORITY DATE CLAIMED  
April 16, 1998TITLE OF INVENTION  
METHOD AND APPARATUS FOR CUTTING FOILS

RECEIVED

APPLICANT(S) FOR DO/EO/US  
Hopfensitz et al.

DEC 21 2006

OFFICE OF PETITIONS

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1.  This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2.  This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3.  This is an express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Articles 22 and 39(1).
4.  A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
5.  A copy of the International Application as filed (35 U.S.C. 371 (c) (2))
  - a.  is transmitted herewith (required only if not transmitted by the International Bureau).
  - b.  has been transmitted by the International Bureau.
  - c.  is not required, as the application was filed in the United States Receiving Office (RO/US).
6.  A translation of the International Application into English (35 U.S.C. 371(c)(2)).
7.  A copy of the International Search Report (PCT/ISA/210).
8.  Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371 (c)(3))
  - a.  are transmitted herewith (required only if not transmitted by the International Bureau).
  - b.  have been transmitted by the International Bureau.
  - c.  have not been made; however, the time limit for making such amendments has NOT expired.
  - d.  have not been made and will not be made.
9.  A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
10.  An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)).
11.  A copy of the International Preliminary Examination Report (PCT/IPEA/409).
12.  A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371 (c)(5)).

## Items 13 to 20 below concern document(s) or information included:

13.  An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
14.  An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
15.  A **FIRST** preliminary amendment.
16.  A **SECOND** or **SUBSEQUENT** preliminary amendment.
17.  A substitute specification.
18.  A change of power of attorney and/or address letter.
19.  Certificate of Mailing by Express Mail
20.  Other items or information:

21. The following fees are submitted:

## BASIC NATIONAL FEE (37 CFR 1.492 (a) (1) - (5)):

<input type="checkbox"/> Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2) paid to USPTO and International Search Report not prepared by the EPO or JPO .....	\$970.00
<input checked="" type="checkbox"/> International preliminary examination fee (37 CFR 1.482) not paid to USPTO but International Search Report prepared by the EPO or JPO .....	\$840.00
<input type="checkbox"/> International preliminary examination fee (37 CFR 1.482) not paid to USPTO but international search fee (37 CFR 1.445(a)(2)) paid to USPTO .....	\$690.00
<input type="checkbox"/> International preliminary examination fee paid to USPTO (37 CFR 1.482) but all claims did not satisfy provisions of PCT Article 33(1)-(4) .....	\$670.00
<input type="checkbox"/> International preliminary examination fee paid to USPTO (37 CFR 1.482) and all claims satisfied provisions of PCT Article 33(1)-(4) .....	\$96.00

ENTER APPROPRIATE BASIC FEE AMOUNT =

\$840.00

Surcharge of \$130.00 for furnishing the oath or declaration later than  20  30 months from the earliest claimed priority date (37 CFR 1.492 (e)).

\$0.00

CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE	
Total claims	14 - 20 =	0	x \$18.00	\$0.00
Independent claims	2 - 3 =	0	x \$78.00	\$0.00
Multiple Dependent Claims (check if applicable).			<input type="checkbox"/>	\$0.00
			<b>TOTAL OF ABOVE CALCULATIONS</b>	<b>\$840.00</b>
Reduction of 1/2 for filing by small entity, if applicable. Verified Small Entity Statement must also be filed (Note 37 CFR 1.9, 1.27, 1.28) (check if applicable).			<input type="checkbox"/>	\$0.00
			<b>SUBTOTAL</b>	<b>\$840.00</b>
Processing fee of \$130.00 for furnishing the English translation later than months from the earliest claimed priority date (37 CFR 1.492 (f)).			<input type="checkbox"/> 20 <input type="checkbox"/> 30 +	\$0.00
			<b>TOTAL NATIONAL FEE</b>	<b>\$840.00</b>
Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31) (check if applicable).			<input checked="" type="checkbox"/>	\$40.00
			<b>TOTAL FEES ENCLOSED</b>	<b>\$880.00</b>
			Amount to be: refunded	\$
			charged	\$

A check in the amount of \$880.00 to cover the above fees is enclosed.

Please charge my Deposit Account No. in the amount of to cover the above fees.  
A duplicate copy of this sheet is enclosed.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 08-2461 A duplicate copy of this sheet is enclosed.

NOTE: Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the application to pending status.

SEND ALL CORRESPONDENCE TO:

Charles R. Hoffmann, Esq.  
Hoffmann & Baron, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791



SIGNATURE

Kevin E. McDermott

NAME

35,946

REGISTRATION NUMBER

September 22, 2000

DATE

Exhibit B



RECEIVED

DEC 21 2006

OFFICE OF PETITIONS

APPLICANT: Hopfensitz et al.

SERIAL NO.: N/A

FILING DATE: September 22, 2000

GROUP ART UNIT: N/A

EXAMINER: N/A

DOCKET: 1093-29 PCT/US

Certificate of Mailing Dated: September 22, 2000

Express Mail Label No.: EL491429994US

The U.S. Patent and Trademark Office date stamp will acknowledge receipt of the following

- Transmittal letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371 (x2)
- German Application
- German Application Translated in English
- Three (3) Sheets of Drawings
- Preliminary Amendment
- Assignment Recordation Cover Sheet (x2)
- Assignment of Invention
- Combined Declaration and Power of Attorney
- Information Disclosure Statement
- PTO-Form 1449
- International Preliminary Examination Report
- Internationaler Recherchenbericht
- Check in amount of \$880.00

SEP 22 2000

KEM:kd

Hoffmann & Baron, LLP  
1093-0029

532 Rec'd PCT/PTC 22 SEP 2000

APPLICANT: Hopfensitz et al.

SERIAL NO.: N/A

FILING DATE: September 22, 2000

GROUP ART UNIT: N/A

EXAMINER: N/A

DOCKET: 1093-29 PCT/US

Certificate of Mailing Dated: September 22, 2000

Express Mail Label No.: EL491429994US

The U.S. Patent and Trademark Office date stamp will acknowledge receipt of the following

- Transmittal letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371 (x2)
- German Application
- German Application Translated in English
- Three (3) Sheets of Drawings
- Preliminary Amendment
- Assignment Recordation Cover Sheet
- Assignment of Invention
- Combined Declaration and Power of Attorney
- Information Disclosure Statement
- PTO-Form 1449
- International Preliminary Examination Report
- Internationaler Recherchenbericht
- Check in amount of \$880.00

KEM:kd

Hoffmann & Baron, LLP  
1093-0029

Exhibit C



09/646944



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

INTERNATIONAL APPLICATION NO. 00606

HOPFENSITZ

FIRST NAMED APPLICANT

R 1093-29 PCT/

ATTY. DOCKET NO.

CHARLES R HOFFMANN  
HOFFMANN & BARON  
6900 JERICHO TURNPIKE  
SYOSSET NY 11791

5071

REC 23 2000

INTERNATIONAL APPLICATION NO. PCT/US00606

LA. FILING DATE 09/01/99 PRIORITY DATE 04/16/98

10/17/00 DATE MAILED:

NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371  
AND 37 CFR 1.494 OR 1.495

1. The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as  a Designated Office (37 CFR 1.494),  an Elected Office (37 CFR 1.495), has determined that the above identified international application has met the requirements of 35 U.S.C. 371, and is ACCEPTED for national patentability examination in the United States Patent and Trademark Office.

2. The United States Application Number assigned to the application is shown above and the relevant dates are:

SEP 22 2000

SEP 22 2000

35 U.S.C. 102(e) DATE

DATE OF RECEIPT OF

35 U.S.C. 371 REQUIREMENTS

A Filing Receipt (PTO-103X) will be issued for the present application in due course. THE DATE APPEARING ON THE FILING RECEIPT AS THE "FILING DATE" IS THE DATE ON WHICH THE LAST OF THE 35 U.S.C. 371(C) REQUIREMENTS HAS BEEN RECEIVED IN THE OFFICE. THIS DATE IS SHOWN ABOVE. The filing date of the above identified application is the international filing date of the international application (Article 11(3) and 35 U.S.C. 363). Once the Filing Receipt has been received, send all correspondence to the Group Art Unit designated thereon.

3.  A request for immediate examination under 35 U.S.C. 371(f) was received on SEP 22 2000 and the application will be examined in turn.

4. The following items have been received:

U.S. Basic National Fee.

Copy of the international application in:

a non-English language.

English.

Translation of the international application into English.

Oath or Declaration of inventors(s) for DO/EO/US.

Copy of Article 19 amendments.  Translation of Article 19 amendments into English.

The Article 19 amendments  have  have not been entered.

The International Preliminary Examination Report in English and its Annexes, if any.

Copy of the Annexes to the International Preliminary Examination Report (IPER).

Translation of Annexes to the IPER into English.

The Annexes  have  have not been entered.

Preliminary amendment(s) filed SEP 22 2000 and \_\_\_\_\_.

Information Disclosure Statement(s) filed SEP 22 2000 and \_\_\_\_\_.

Assignment document.

Power of Attorney and/or Change of Address.

Substitute specification filed \_\_\_\_\_.

Verified Statement Claiming Small Entity Status.

Priority Document.

Copy of the International Search Report  and copies of the references cited therein.

Other.

RECEIVED

DEC 21 2006

OFFICE OF PETITIONS

Exhibit D



DECEMBER 01, 2000

PTAS

HOFFMAN & BARON, LLP  
CHARLES R. HOFFMANN, ESQ.  
6900 JERICHO TURNPIKE  
SYOSSET, NY 11791

DEC 1 2000



\*101485969A\*

RECEIVED

DEC 21 2006

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

OFFICE OF PETITIONS

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 09/22/2000

REEL/FRAME: 011140/0304  
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:  
HOPFENSITZ, RALPH

DOC DATE: 08/31/2000

ASSIGNOR:  
LUTZ, NORBERT

DOC DATE: 08/31/2000

ASSIGNEE:  
LEONHARD KURZ GMBH & CO.  
SCHWABACHER STRASSE 432  
DE-90763 FURTH, FED REP GERMANY

SERIAL NUMBER: 09646944  
PATENT NUMBER:

FILING DATE: 09/22/2000  
ISSUE DATE:

MARY BENTON, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

Exhibit E



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

Applicant(s)	Hopfensitz et al.	Examiner:	N/A	DEC 21 2006
Serial No.:	09/646,944	Group Art Unit:	N/A	OFFICE OF PETITIONS
Filed:	September 22, 2000	Docket:	1093-29 PCT/US	
For:	METHOD AND APPARATUS FOR CUTTING FOILS	Dated:	March 12, 2003	

Commissioner for Patents  
Washington, DC 20231

*I hereby certify this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to: Commissioner for Patents, Washington, D.C. 20231 on March 12, 2003.*

Signature: 

REQUEST FOR STATUS OF APPLICATION

Sir:

Notification of acceptance of the above-identified patent application for national patentability examination was mailed on October 17, 2000. Applicants have not received a Filing Receipt or any further communications from the Patent Office as of this date.

Applicants hereby request information on the status of the above-referenced application and when a Filing Receipt and a first Office Action will be issued.

Dated: March 12, 2003



Kevin E. McDermott  
Registration No.: 35,946  
Attorney for Applicants

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791  
(516) 822-3550

169847\_1



**APPLICANT:** Hopfensitz et al.  
**SERIAL NO.:** 09/646,944  
**FILING DATE:** September 22, 2000  
**CONFIRMATION NO.:** 9135  
**GROUP ART UNIT:** Unassigned  
**EXAMINER:** Unassigned  
**DOCKET:** 1093-29 PCT/US

**Certificate of Mailing Dated:** March 12, 2003  
 **Express Mail Label No.:**

The U.S. Patent and Trademark Office date stamp  
will acknowledge receipt of the following

**Request for Status of Application**

**KEM:sbs**  
Hoffmann & Baron, LLP  
1093-29 PCT/US (0029)

**APPLICANT:** Hopfensitz et al.  
**SERIAL NO.:** 09/646,944  
**FILING DATE:** September 22, 2000  
**CONFIRMATION NO.:** 9135  
**GROUP ART UNIT:** Unassigned  
**EXAMINER:** Unassigned  
**DOCKET:** 1093-29 PCT/US

**Certificate of Mailing Dated:** March 12, 2003  
 **Express Mail Label No.:**

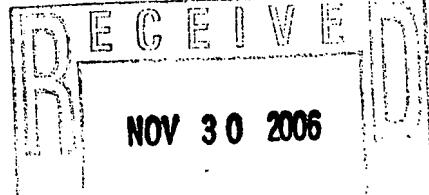
The U.S. Patent and Trademark Office date stamp  
will acknowledge receipt of the following

**Request for Status of Application**



**KEM:sbs**  
Hoffmann & Baron, LLP  
1093-29 PCT/US (0029)

Exhibit F



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
 United States Patent and Trademark Office  
 P.O. Box 1450  
 Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

# Fax Cover Sheet

RECEIVED

DEC 21 2006

Date: 30 Nov 2006

OFFICE OF PETITIONS

To: Kevin McDermott	From: Samuel M. Heinrich
Application/Control Number: 09/646,944	Art Unit: 1725
Fax No.: 516 822 3582	Phone No.: 571-272-1175
Voice No.: 516 822 3550	Return Fax No.: (571) 273-8300
Re: SN09646944	CC:

Urgent    For Review    For Comment    For Reply    Per Your Request

## Comments:

This FAX includes a copy of the Office Action mailed 03/28/2002 and includes reference JP09277196A which was relied on in the USC 103 rejection.

Number of pages 16 including this page

## STATEMENT OF CONFIDENTIALITY

This facsimile transmission is an Official U.S. Government document which may contain information which is privileged and confidential. It is intended only for use of the recipient named above. If you are not the intended recipient, any dissemination, distribution or copying of this document is strictly prohibited. If this document is received in error, you are requested to immediately notify the sender at the above indicated telephone number and return the entire document in an envelope addressed to:

Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Exhibit G



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09/646,944	09/22/2000	Ralph Hopfensitz	1093-29-PCT/4S	1310

7500  
Hoffmann & Baron  
350 Jericho Turnpike  
Jericho, NY 11753

03/28/2002

NOV 30 2006

EXAMINER

HEINRICH, SAMUEL M

ART UNIT

PAPER NUMBER

1725

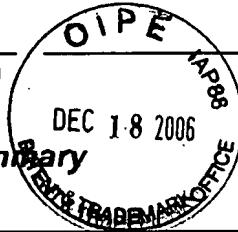
DATE MAILED: 03/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

DEC 21 2006

OFFICE OF PETITIONS



## Office Action Summary

Application No.	Applicant(s)	
09/646,944	HOPFENSITZ ET AL	
Examiner	Art Unit	
Samuel M Heinrich	1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on \_\_\_\_\_.
- 2a)  This action is FINAL. 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-14 is/are rejected.
- 7)  Claim(s) 4-14 is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 22 September 2000 is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> .	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

Claims 4-14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from other multiple dependent claims. See MPEP § 608.01(n). Accordingly, **claims 4-14 have not been further treated on the merits.**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, line 3, "in particular" causes the scope of the claim to be indefinite. The parenthetical limitations in all of the claims causes the scope of the claims to be unclear.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP09277196A. The abstract describes a "film, e.g. sheet material, paper, metal foil – involves using cutting patterns formed by irradiation of laser beam" with subsequent blade cutting. See the Figures. The use of a particular film such as the instant claimed "carrier film and a decorative layer" would have been obvious at the time applicant's invention was made to a person of ordinary skill in the art because the particular film is an equivalent film to those disclosed by JP09277196A.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited art pertains to cutting using both laser and blade.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel M Heinrich whose telephone number is 703 308 1168. The examiner can normally be reached on M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G Dunn can be reached on 703 308 3318. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 3599 for regular communications and 703 305 6078 for After Final communications.